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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,611	08/16/2006	Koji Kamei	Q80165	8630
23373	7590	11/13/2008	EXAMINER	
SUGHRUE MION, PLLC			TRAN, TRANG Q	
2100 PENNSYLVANIA AVENUE, N.W.				
SUITE 800			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20037			2811	
			MAIL DATE	DELIVERY MODE
			11/13/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/589,611	KAMEI, KOJI
	<b>Examiner</b>	<b>Art Unit</b>
	TRANG Q. TRAN	2811

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 October 2008.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.  
 4a) Of the above claim(s) 16 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-15 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 16 August 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/16/06 and 10/23/07</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Election/Restrictions***

Applicant's election without traverse of Group 1 (claims 1-15) in the reply filed on September 19, 2009 is acknowledged.

Claim 16 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 19, 2009.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a) because they fail to show the contact metal layer and a positive-electrode-metal-containing layer as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the

remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is failing to particularly point out and distinctly define the metes and bounds of the subject matter because it is unclear what the preamble of the claim is.

Re. claim 1, the recited limitation of "the layers being successively provided atop the substrate in this order" is unclear as to which layers and which order is this order that the applicant refers.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-2, 4, 5, 8-9, 12 and 14-15** are rejected under 35 U.S.C. 102(b) as being anticipated by Onomura et al. (6,067,309).

Re. claim 1, Fig. 1 of Onomura discloses a gallium nitride compound semiconductor light-emitting device including a substrate (1), an n-type semiconductor layer (3+4), a light-emitting layer (6), a p-type semiconductor layer (7+8), a negative electrode (14) provided in contact with the n-type semiconductor layer (3+4), and a positive electrode (10+11a+11+12+13) provided in contact with the p-type semiconductor layer (7+8), the layers being successively provided atop the substrate in this order and being composed of a gallium nitride compound semiconductor (as seen in Fig. 1), wherein

the positive electrode (10+11a+11+12+13) includes at least a contact metal layer (10) which is in contact with the p-type semiconductor layer (7+8),

the contact metal layer (10) comprises at least one metal selected from the group consisting of Pt, and

the surface portion of the p-type semiconductor layer (7+8) on the positive electrode side includes a positive-electrode-metal-containing layer (15) that contains at least one metal selected from the group consisting of Pt.

Re. claim 2, Onomura discloses the gallium nitride compound semiconductor light-emitting device according to claim 1, wherein the positive-electrode-metal-

containing layer has a thickness of 0.1 to 10 nm.

**Re. claim 4**, Onomura discloses the gallium nitride compound semiconductor light-emitting device according to claim 1, wherein the positive electrode includes a reflecting layer (12) on the contact metal layer (10), the reflecting layer comprising at least one metal selected from the group consisting of Pt.

**Re. claim 6**, Onomura discloses the gallium nitride compound semiconductor light-emitting device according to claim 4, wherein the contact metal layer (10) has a thickness of 1 to 30 nm (Col. 6, lines 34-36 discloses the contact metal layer (10) has a thickness of 5 nm).

**Re. claim 8**, Onomura discloses the gallium nitride compound semiconductor light-emitting device according to claim 1, wherein the surface portion of the contact metal layer (10) on the p-type semiconductor layer side includes a semiconductor-metal-containing layer (9) that contains a Group III metal (GaN).

**Re. claim 9**, Onomura discloses the gallium nitride compound semiconductor light-emitting device according to claim 8, wherein the semiconductor-metal-containing layer (9) further contains a nitrogen atom (as seen in Fig. 1).

**Re. claim 12**, Onomura discloses the gallium nitride compound semiconductor light-emitting device according to claim 1, wherein the contact metal layer (10) comprises Pt.

**Re. claim 14**, Onomura discloses the gallium nitride compound semiconductor light-emitting device according to claim 1, wherein the contact metal layer is formed through RF discharge sputtering (See Note 1).

**Re. claim 15**, Onomura discloses the gallium nitride compound semiconductor light-emitting device according to claim 4, wherein the contact metal layer is formed through RF discharge sputtering, and the reflecting layer is formed through DC discharge sputtering (See Note 1).

Note 1: Claims 14 and 15 are drawn to a process by which the product is made. Even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Because the product by process does not change the end product, Applicant's claimed invention does not distinguish over prior art. See MPEP § 2113.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 3, 5, 7, 10-11 and 13** rejected under 35 U.S.C. 103(a) as being unpatentable over Onomura.

**Re. claim 3**, Onomura discloses the gallium nitride compound semiconductor light-emitting device according to claim 1, wherein the positive-electrode-metal-containing layer (15) contains at least one metal selected from the group consisting of Pt at a concentration of 0.01 to 30 at. % with respect to the total amount of metal atoms contained in the positive-electrode-metal-containing layer.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to implant dopant atoms between about 0.01 to 30 at. % with respect to the total amount of metal atoms, in order to reduce the resistivity of the device.

Generally, differences in concentration do not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955). See also *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969). For more recent cases

applying this principle, see *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989), and *In re Kulling*, 897 F.2d 1147, 14 USPQ2d 1056 (Fed. Cir. 1990).

**Re. claim 5**, Onomura discloses the gallium nitride compound semiconductor light-emitting device according to claim 4, wherein the reflecting layer (12) has a columnar crystal structure.

Onomura teaches the reflecting layer (12) has the same material as claimed invention, therefore it is obvious to has a columnar crystal structure in order to achieve the property of the device.

**Re. claim 7**, Onomura discloses the gallium nitride compound semiconductor light-emitting device according to claim 4, wherein the reflecting layer has a thickness of 30 to 500 nm.

Col. 6, lines 34-36 of Onomura discloses the contact metal layer (10) has a thickness of 10 nm.

Onomura may not explicitly teach the reflecting layer has a thickness of 30 to 500 nm.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide certain thickness of the reflecting layer, since it has been held that discovering the optimum or workable ranges involves only routine skill in the

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art. *In re Aller*, 105 USPQ 233; *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980); *In re Huang*, 100 F.3d 135, 40 USPQ2d 1685, 1688 (Fed. Cir. 1996).

**Re. claim 10**, Onomura discloses the gallium nitride compound semiconductor light-emitting device according to claim 8, Onomura may not explicitly teach wherein the semiconductor-metal-containing layer (9) has a thickness of 0.1 to 3 nm.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide certain thickness of the semiconductor-metal-containing layer, since it has been held that discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233; *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980); *In re Huang*, 100 F.3d 135, 40 USPQ2d 1685, 1688 (Fed. Cir. 1996).

**Re. claim 11**, Onomura discloses the gallium nitride compound semiconductor light-emitting device according to claim 8, wherein the semiconductor-metal-containing layer (9) contains a Group III metal (GaN)

Onomura may not explicitly teach the semiconductor-metal-containing layer contains a Group III metal at a concentration of 0.1 to 50 at. % with respect to the total amount of metal atoms contained in the semiconductor-metal-containing layer.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to implant dopant atoms between 0.1 to 50 at. % with respect to the total amount of metal atoms, in order to reduce the resistivity of the device.

Generally, differences in concentration do not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955). See also *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969). For more recent cases applying this principle, see *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989), and *In re Kulling*, 897 F.2d 1147, 14 USPQ2d 1056 (Fed. Cir. 1990).

**Re. claim 13**, Onomura discloses the gallium nitride compound semiconductor light-emitting device according to claim 12, Onomura may not explicitly teach wherein the contact metal layer has a Pt(222) plane spacing of 1.130 .ANG. or less.

However, it would have been obvious to one of ordinary skill in the art the time the invention was made to provide the contact metal layer has a Pt(222) plane spacing of 1.130 .ANG. or less to improve crystal defect.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRANG Q. TRAN whose telephone number is (571)270-3259. The examiner can normally be reached on Mon - Thu (9am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne A. Gurley can be reached on 571-272-1670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. Q. T./  
Examiner, Art Unit 2811  
/Cuong Q Nguyen/  
Primary Examiner, Art Unit 2811